



AP/IFW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Daisuke KAMIYA

Group Art Unit: 1711

Application No.: 10/505,409

Examiner: Thao T. Tran

Filed: October 24, 2004

Attorney Docket No.: 7378/84103

Confirmation No: 7763

Customer No.: 42798

RESPONSE TO NOTICE DATED May 8, 2007

MAIL STOP APPEAL BRIEF-PATENTS

Commissioner for Patents
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

In response to the Miscellaneous Paper dated May 8, 2007, as entered in the above-captioned matter, the Appellants' Appeal Brief was identified as defective for the new reasons "A/ The official Appeal Brief should not have markings thereon. B/ Each independent claim must be recited by the claim number. [and] C Each limitation of each independent claim should be mapped to the specification by page and line numbers."

The Appellants have again carefully reviewed their summary section and consulted with others at the PTO, as well as former members of the Board. With all due respect, Appellants find their Appeal Brief as filed on November 17, 2006 to be fully compliant with the requirements of 37 C.F.R. §41.37.

- A. Appellants' submitted an Appeal Brief on November 17, 2006, and a courtesy copy with mark-ups as an attachment to their Response filed January 11, 2007. Appellants submit Item A is mistaken and should be withdrawn.**

First, the May 8, 2007 Notice at box 10, item A, refers to the courtesy, duplicate copy of Appellant's November 17, 2006 Appeal Brief that accompanied Appellants' January 11, 2007 Response. The Notice is mistaken in its inception. That courtesy copy included mark-ups in a good faith effort to demonstrate the November 17, 2006 Appeal Brief presented Appellants' case consistent with the requirements of 37 C.F.R. §41.37. Accordingly, Appellants' submit the item A is perhaps an inadvertent oversight, and courteously submit it should be withdrawn.

- B. Appellants' submitted an Appeal Brief on November 17, 2006, and the summary section thereof summarized the claimed subject matter in accordance with 37 C.F.R. §41.37, and therefore Item B is erroneous.**

Second, the May 8, 2007 Notice at box 10, item B/, asserts that the Appeal Brief as filed November 17, 2006 was defective because the summary section did not recite independent claims by claim number. Appellants submit item B in the Notice is arbitrary and capricious. The PTO rule **does not** require recitation of a claim number in the summary section of the Appeal Brief. Particular reference was made in the present Miscellaneous Paper in the checked box 4 to the requirements of 35 C.F.R. §41.37(c)(1)(v). That section first requires:

A concise explanation of *the subject matter* defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawings, if any, by reference characters.

(emphasis added).

The PTO rule provides a concise explanation of the "*subject matter*" of the independent claims should be included in the summary section. Appellant's November 17, 2006 Appeal Brief does exactly that. Appellants' Appeal Brief presented their claims, in prose format, including references to the specification by page and line number.

The *subject matter* of independent claim 1 is summarized in the summary section as seen from the attached marked-up copy of the Appeal Brief Section as seen from the attached marked-up copy of the November 17, 2006 Appeal Brief that was appended to Appellants' January 11, 2007 Response. The *subject matter* of independent claim 1 rests on the original specification, including, by way of non-limiting examples, pages 6 and 8, as well as at page 5, lines 19-26, page 7, lines 22-23, page 8, lines 2-4, page 8, lines 5-6 and lines 8-14, as summarized at pages 3 and 4 of the November 17, 2006 Appeal Brief.

The *subject matter* of independent claim 5 is summarized in the Summary Section as seen from the attached marked-up copy of the November 17, 2006 Appeal Brief appended to Appellants' January 11, 2007 Response. The *subject matter* of independent claim 5 rests on the original specification, including, the non-limiting passages mentioned as to independent claim 1, as well as, for instance, 8 at line 21 to page 9, line 14, as summarized at pages 3 and 4 (as to claim 1) and at page 5 (as to independent claim 5) of the November 17, 2006 Appeal Brief.

The citations to the specification in the summary section are exemplary and are intended to assist the Board in comprehending the *subject matter* of the claims involved in the Appeal, without being an estoppel against Appellant. As a matter of course, the Appellants sought to provide their position in a manner sufficient for the Examiner to prepare an Examiner's Answer.

- C. **Appellants' submitted an Appeal Brief on November 17, 2006 relating to inventions that are not claimed in means-plus-function language. Appellants' independent claims on appeal are to "A pressure-sensitive adhesive..." (claim 1) and "A pressure-sensitive adhesive sheet..." (claim 5), but neither is presented the means-plus-function language of 35 U.S.C. §112(¶6). There is no statutory or regulatory basis for requiring Appellants to have additionally "mapped" each of these readily understood independent claims to their specification in the summary section of such Appeal Brief.**

Third, the May 8 , 2007 Notice at box 10, item C/, asserts that the Appeal Brief as filed November 17, 2006 was defective because the "[e]ach limitation of each independent claim

seem to expand on the language in the form text associated with checked Box 4. Regardless, Appellants submit Item C in the Notice is arbitrary and capricious.

The Code of Federal Regulations, title 37, subpart 41.37, further provides as follows:

For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. §112, 6th paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

There are no independent or dependent claims being presented for argument that include a means plus function or step plus function recitation. Therefore, this section of 35 C.F.R. §41.37(c)(1)(v) is not applicable, and thus there is no statutory or regulatory requirement for Appellants to have “mapped” their independent claims 1 and 5 in this straight forward appeal. The independent claims are readily understood.

Appellants point out their Appeal Brief summarized the “subject matter” of independent claims 1 and 5 consistent with 37 C.F.R. §41.37.

There are no other specific requirements set forth in the Code of Federal Regulations.

Rule 133 Statement

Applicants’ legal representative acknowledges a telephone conversation with the Supervisory Examiner on May 10, 2007 in an effort to solicit further explanation for the defects alleged. The Supervisory Examiner directed Appellants to Ms. Jenifer Michener at 571-272-1424. A call was placed to Ms. Michener, among others.

Conclusion

The Appellants therefore respectfully submit their Appeal Brief as submitted on November 16, 2006 presented the appeal consistent with the requirements of the PTO's rules and did so in a form so as to enable the Examiner to prepare an Examiner's Answer or, following the appeal conference, issue an allowance or to re-open patent prosecution. In particular, the summary of claimed subject matter section of the Appeal Brief is fully compliant with the requirements of the Code of Federal Regulations and is in suitable condition to support consideration by the Board.

Appellants respectfully submit the Notice should be withdrawn and the Appeal Brief as originally filed November 17, 2006 should be entered.

Appellants courteously solicit favorable reconsideration followed by the internal PTO appeal conference and thence notice withdrawing the rejections on appeal, an Examiner's Answer, or a new office action that re-opens patent prosecution.

Respectfully submitted,

Fitch, Even, Tabin & Flannery

Date: May 10, 2007



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LEXSEE 849 F.2D 581

Analysis
As of: May 04, 2007

OKA ET AL., Appellant, v. YOUSSEFYEH ET AL., Appellee.

87 -1501

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

849 F.2d 581; 1988 U.S. App. LEXIS 19527; 7 U.S.P.Q.2D (BNA) 1169

January 29, 1988, Decided

SUBSEQUENT HISTORY: [****1**] Published Opinion
Issued June 15, 1988.**PRIOR HISTORY:** Appealed from: Patent and
Trademark Office Board of Patent Appeals and
Interferences.Unpublished Opinion of January 29, 1988, Reported at:
*1988 U.S. App. LEXIS 977.***DISPOSITION:** REVERSED.**COUNSEL:** Barry E. Bretschneider, Wegner &
Bretschneider, of Washington, D.C., argued for
appellant. With him on the brief were Harold C. Wegner
and Helmuth A. Wegner.Stephen D. Murphy, Scully, Scott, Murphy & Presser, of
Garden City, New York, argued for appellee. With him
on the brief was Frank S. Digiglio.**JUDGES:** Before MARKEY, Chief Judge, RICH,
Circuit Judge, and MILLER, Senior Circuit Judge.**OPINION BY:** MARKEY**OPINION:** [***582**] MARKEY, Chief Judge.

The Patent and Trademark Office Board of Patent Appeals and Interferences (board), in Interference No. 101,111, awarded priority of invention to junior party Youssefyeh et al. over senior party Oka et al., who relied on their October 31, 1980 Japanese filing date under 35 U.S.C. § 119. We reverse.

Background

The sole generic count in the interference is directed to compounds possessing angiotensin converting enzyme inhibition activity, and is set forth as [****2**] follows:

[SEE DIAGRAM IN ORIGINAL]

wherein:

R and R[9] are independently hydroxy or
lower alkoxy;

[***583**] R[1] is hydrogen, lower alkyl or
aryl lower alkyl;

R[2], R[3], R[4], R[5], R[7] and R[8] are
hydrogen or lower alkyl;

R[6] is indanyl;

and their pharmaceutically acceptable
salts.

The compounds can be described as optionally esterified carboxyalkyl substituted dipeptides that contain two amino acid groups, one of which, typically a glycine, bears a group R[6], defined as an "indanyl group". The indanyl glycine of the count may be a Cycloaliphatically-bonded Indanyl, typically a 2-indanyl group, or an Aromatically-bonded Indanyl, typically a 5-indanyl group.

On February 27, 1980, one of Youssefyeh's co-inventors, Suh, recorded in his notebook this structural formula, encompassing billions of compounds within the

class of 2-Indanyl Glycines:

[SEE DIAGRAM IN ORIGINAL]

OPINION

Conception requires (1) the idea of the structure of the chemical compound, and (2) possession of an operative method of making it. *Coleman v. Dines*, 754 F.2d 353, 359, 224 U.S.P.Q. (BNA) 857, 862 (Fed. Cir. 1985); *Alpert v. Slatin*, 49 C.C.P.A. 1343, 305 F.2d 891, 894, 134 U.S.P.Q. (BNA) 296, 299 (CCPA 1962); [**3] see *Standard Oil Co. v. Montedison*, 494 F. Supp. 370, 407, 206 U.S.P.Q. (BNA) 676, 711-12 (D. Del. 1980), aff'd, 664 F.2d 356, 212 U.S.P.Q. (BNA) 327 (3d Cir. 1981). Youssefyeh quotes from *Townsend v. Smith*, 17 C.C.P.A. 647, 36 F.2d 292, 295, 4 U.S.P.Q. (BNA) 269, 271 (CCPA 1929):

Conception may conveniently be considered as consisting of two parts. The first part is "the directing conception" and may be defined as the idea or conception that a certain desired result may be obtained by following a particular general plan. The directing conception is often referred to as the inventive concept, thought or idea. The second part of conception is "the selection of the means for effectively carrying out the directing conception."

When, as is often the case, a method of making a compound with conventional techniques is a matter of routine knowledge among those skilled in the art, a compound has been deemed to have been conceived when it was described, and the question of whether the conceiver was in possession of a method of making it is simply not raised. In the present case, the board itself recognized that conception required both a description, i.e., the idea, [**4] of a compound and possession of a method for making it. In denying Youssefyeh's claim of February 27, 1980, as its conception date, the board said:

It is Youssefyeh's position that conception occurred on February 27, 1980, * * * because the inventors believed on that date that the compounds could be prepared in accordance with conventional techniques. However, Bernstein, a skilled Ph.D. chemist, spent over six months and was not successful in preparing the 2-indanyl compounds within the scope of the count, a circumstance which indicates that the inventors did not contemplate an operative invention, e.g., an operative method for making the compounds as of

February 27, 1980.

The board made these not clearly erroneous findings: (1) because Youssefyeh had only the idea of a 2-indanyl class of compounds on February 27, 1980, it did not establish conception on that date; (2) Youssefyeh was in possession of a method of making a compound outside the scope of the interference count on October 10, 1980; (3) during the last week of October 1980, co-applicant Suh directed his assistant to use the October 10, 1980 method to prepare a species of a 5-indanyl class of compounds within [**5] the scope of the interference count; (4) the assistant successfully did so in December 1980; (5) Youssefyeh reduced the [**584] invention to practice on January 9, 1981. n1 Based on findings (2), (3), and (4), the board found that "an operative procedure was realized for preparing the 5-indanyl compound" as of October 10, 1980. That finding was clearly erroneous.

n1 In view of our determination respecting conception, we need not and do not reach the parties arguments on diligence and reduction to practice, except to note that neither party argues that the dual requirement for conception of an operative invention (idea plus method of making) equates conception with reduction to practice. The latter in this case would involve verification of the compound's utility as a hypotensive agent.

The board correctly noted that conception of a species within a genus may constitute conception of the genus. *Miller v. Walker*, 214 U.S.P.Q. (BNA) 845, 847 (Bd. Pat. Int. 1982); see *Mikus v. Wachtel*, 504 F.2d 1150, 1151, 183 U.S.P.Q. (BNA) 752, 753 (CCPA 1974) [**6] (reduction to practice of species established priority to genus). However, as Youssefyeh acknowledges, 2-indanyl compounds and 5-indanyl compounds are different species within the generic interference count. Youssefyeh did not conceive of the 2-indanyl compound as an operative invention on February 27, 1980 because it lacked at that time (and on this record never acquired) possession of a method for making it. Youssefyeh did not conceive of the 5-indanyl compound as an operative invention on October 10, 1980 because it lacked at that time the idea of the 5-indanyl compound, and the method it then possessed was a method for making something else. Thus Youssefyeh did not establish conception of either species before Oka's filing date.

That the October 10 method was found in December, after Oka's filing date, to be an effective method of making the 5-indanyl compound did not serve to move the date on which Youssefyeh had the idea of the 5-

indanyl compound back to October 10, 1980. There is no evidence that that method could be used to make the 2-indanyl compound, and, given the difference between aromatically-bonded and cycloaliphatically-bonded indanyl glycines, there is no basis [**7] for a view that a description or method of making one is applicable to the other. The board made no finding that Youssefyeh had the idea of a 5-indanyl compound before the last week of October 1980. Youssefyeh does not argue, and no one testified, that it did have that idea before that time. The record would not in any event support such a finding. The board therefore erred in determining that Youssefyeh had established conception as of October 10, 1980.

Because Oka is the senior party, Youssefyeh was required to establish reduction to practice before Oka's filing date, or conception before that date coupled with reasonable diligence from just before that date to Youssefyeh's filing date. 35 U.S.C. § 102(g); see *Bey v. Kollonitsch*, 806 F.2d 1024, 1030-31, 231 U.S.P.Q. (BNA) 967, 972 (Fed. Cir. 1986). The board's finding that Youssefyeh initiated preparation of a 5-indanyl compound "in the last week of October 1980" supports the conclusion that Youssefyeh failed to establish conception, much less a reduction to practice, of that class of compounds earlier than October 31, 1980. In dealing with a reduction to practice, the court in *Haultain v. DeWindt*, 45 C.C.P.A. 866, 254 F.2d 141, 117 U.S.P.Q. (BNA) 278 (CCPA 1958), [**8] stated,

"Further, where testimony merely places the acts within a stated time period, the inventor has not established a date for his activities earlier than the last day of the period." 254 F.2d at 142, 117 U.S.P.Q. (BNA) at 279. That rule is equally appropriate in establishing a date of conception, nor does Youssefyeh dispute Oka's position that "the last week in October" means October 31.

Thus Youssefyeh's conception and Oka's filing date are the same, i.e., October 31, 1980. Oka, as the senior party, is presumptively entitled to an award of priority, and Youssefyeh, as the junior party in an interference between pending applications, must overcome that presumption with a preponderance of the evidence. *Morgan v. Hirsch*, 728 F.2d 1449, 1451, 221 U.S.P.Q. (BNA) 193, 194 (Fed. Cir. 1984); 37 C.F.R. § 1.257(a) (1983). In the event of a tie, therefore, priority must be awarded to the senior party. Accord *Yamaha Int'l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 1580 n.11, 6 U.S.P.Q.2D (BNA) 1001, 1008 n.11 [*585] (Fed. Cir. 1988) (In a trademark opposition, "where the evidence is so evenly balanced that no preponderance emerges . . . , the party having the burden of persuasion necessarily [**9] loses."). Because Youssefyeh, the junior party, failed to show a conception date earlier than Oka's filing date, Oka is entitled to priority. We reverse the board's award of priority to Youssefyeh.

REVERSED.

45 C.C.P.A. 866, *; 254 F.2d 141, **;
1958 CCPA LEXIS 197, ***; 117 U.S.P.Q. (BNA) 278

LEXSEE 254 F.2D 141

Caution
As of: May 03, 2007

HAULTAIN v. DEWINDT

No. 6289

United States Court of Customs and Patent Appeals

45 C.C.P.A. 866; 254 F.2d 141; 1958 CCPA LEXIS 197; 117 U.S.P.Q. (BNA) 278

Oral argument November 5, 1957

April 11, 1958

PRIOR HISTORY: [***1]

APPEAL from Patent Office, Interference No. 86,827

DISPOSITION:

Affirmed.

COUNSEL:

Marcus Lothrop and Bacon & Thomas for appellant.

Pennie, Edmonds, Morton, Barrows and Taylor
(*Merton S. Neill* and *Clarence M. Fisher* of counsel) for appellee.

OPINION BY:

RICH

OPINION: [**141]

[*867] Before JOHNSON, Chief Judge, and O'CONNELL, WORLEY, RICH, and JACKSON (retired), Associate Judges

RICH, Judge, delivered the opinion of the court:

This appeal is from the decision of the Board of Patent Interferences in Interference No. 86,827, awarding priority to the junior party DeWindt. The involved applications are DeWindt's "Conveyor Flight Belt," filed May 29, 1953, serial No. 358,482, assigned to the Ton-Tex Corporation, and Haultain's "Cleated Belt" filed June 9, 1952, serial No. 292,472.

The single count involved is as follows:

A cleated belt comprising a belt web including reinforcing plies and a rubber-like superficial portion, there being a gap in said superficial portion to expose said reinforcing plies, a cleat member capable of vulcanization and including reinforcing plies bent into an L-shape, the leg of the L being disposed at a right [**142] angle to said web and [***2] the foot of the L being disposed parallel to said web in said gap in contact with said reinforcing plies, and a rubberlike superficial portion on said cleat member merging smoothly with said superficial portion of said web, said superficial portions, said cleat member and said web being vulcanized together. [Emphasis ours.]

[*868] The board awarded DeWindt a conception date of October 16, 1951 and held that he actually reduced the invention to practice on June 4, 1952.

The board awarded appellant, Haultain, a conception date of "early in 1952" but held that the evidence did not establish an actual reduction to practice by him.

The subject matter of the instant interference is the construction of a cleated conveyor belt. More specifically, the invention involves the use of an inverted T-shaped, or double L-shaped cleat. The inverted T is placed in a gap or depression formed in the belt surface. For example, in a five ply belt, one or two plies are removed transversely of the belt, forming a gap having a width sufficient to accommodate the base of the cleat, i.e., the top of the T. The cleat is then vulcanized into the

belt and becomes an integral part thereof. [***3]

Haultain contends that DeWindt was not diligent between conception and reduction to practice; that the belts actually made by DeWindt do not conform to the count, in that they lack a superficial rubber-like layer; that the tests run by DeWindt do not constitute an actual reduction to practice and as such do not overcome Haultain's filing date; and that Haultain had an actual reduction to practice before the filing of his application.

[1] DeWindt contends that he had a conception and an actual reduction to practice before Haultain's filing date and that Haultain has no actual reduction to practice and must rely on his filing date. It is well to note that the earliest date the preliminary statement of DeWindt alleges is the latter part of 1950, and proof of any earlier date will establish no date earlier than the date alleged in said statement. [2] Further, where testimony merely places the acts within a stated time period, the inventor has not established a date for his activities earlier than the last day of the period.

There is testimony of conception of the invention by DeWindt in late July 1950. There is also testimony by various witnesses for DeWindt who speak of [***4] sketches and samples being made following that date, but none of these samples or sketches was produced and we do not find the testimony at all convincing. We find no clear or convincing evidence which would establish conception by DeWindt prior to August 17, 1951, when he prepared a sketch which was sent to one Meyers, a Ton-Tex sales manager, who received it on October 16, 1951, for delivery to Ton-Tex's patent counsel for search purposes. Chapman and Beaman, officials of Ton-Tex and familiar with the development of the DeWindt work, both testified that they saw the sketch made by DeWindt, apparently at Beaman's request, before it was sent to Meyers. Chapman and Beaman did not state when they saw the sketch, but did indicate that the particular sketch was the one they saw, and the record shows a carbon copy of a letter [*869] dated October 16, 1951 from Beaman to Meyers wherein the sketch is referred to. The letter also mentions a sample being forwarded under separate cover. The sample is identified as one of the exhibits before us. The sketch clearly shows the structure defined by the count except for the "rubberlike superficial portion" of the belt web. However, we [***5] believe this lack is overcome by the sample to which the letter refers. Counsel for Haultain argues vigorously that the outer surface of the belt is not rubber-like. We have examined the exhibit and find, despite the fact the surface has somewhat the texture of canvas, that the surface is also impregnated with a rubbery substance which forms a very thin film over the entire surface which, we feel,

satisfies the above-mentioned language. [**143] This evidence, we feel, fully supports the board's finding that DeWindt conceived at least as early as October 16, 1951.

[3] DeWindt claims that the earlier use of a "Dutchman," which is a section inserted into an existing belt, containing a single flight or cleat, alleged to have been made and tested by March 13, 1951, constituted an actual reduction to practice as of that date. Assuming, without deciding, that the "Dutchman" embodied the invention here in issue, we agree with the board that the test was legally insufficient in view of the inter-office memorandum, addressed to Chapman, the pertinent portion of which reads:

In July 1951, Ternstedt Eng Dept stated the test made on the sample seemed very good but that for test purposes [***6] a complete belt would give a far more satisfactory test. You see the pieces dropping on the conveyor are very slow and the sample piece of flight belt only carried approx one piece every 45 minutes.

Therefore, we agree that the alleged March 13, 1951 test does not establish an actual reduction to practice. *Balogh v. Crot*, 37 C.C.P.A. (Patents) 707, 176 F.2d 923, 83 USPQ 130; *Martin et al. v. Snyder*, 41 C.C.P.A. (Patents) 1010, 214 F.2d 177, 102 USPQ 306.

As indicated above, Ternstedt wished a complete belt in order to perform the required testing. Subsequently an estimate of cost and a three flight section were sent to Ternstedt. This too was inserted as a Dutchman. We feel this second test also fails to show an actual reduction to practice for the same reason as the first single flight belt section. Ternstedt was still not satisfied with the test of anything less than a complete belt.

Eventually, however, Chapman elected to send a complete belt to a Ford Motor Company plant, for which no charge was made. There appears to be a little confusion as to the exact date when the test belt was installed in the Ford plant, but there is a confirmatory paper from Ford dated May [***7] 16, 1952, wherein receipt of the test belt is acknowledged. That the Ford belt conformed to the count (and to the earlier-mentioned sample sent for a patent search) is deemed to [*870] be adequately corroborated by the testimony of Peddicord and Chapman.

The following testimony of Peddicord we think adequately establishes that the test belt was satisfactory and tested under actual working conditions:

* * *

Q105. Was that belt then delivered to Ford? A. That belt was delivered to Ford inside of the next two or

three days, which was delivered by Mr. Peabody.

Q106. Did you ever see that belt in operation at the Ford Highland Park Plant? A. I checked on this operation myself in the latter part of May of that year.

Q107. Do you recall whom you saw at the Ford plant at that time? A. As this program was - or, I should say, the original inquiry and talks were with Mr. Phil Grushaw; then on my visit for inspection in May of '52, Mr. Grushaw himself personally, and Mr. Peabody and myself, inspected the belt, which was in operation at that time.

Q108. How was it being used? A. This was being used as a conveyor for the valve-guide job off of an automatic machine. [***8]

Q109. Do you recall anything as to the speed of the belt? A. I would say this probably ran around approximately 80 to 100 feet per minute.

Q110. And what was it doing with the parts that were being discharged on to it? A. These parts were being elevated into a box.

Q111. Did you have occasion to inspect the belt, stationary? A. As I recall we were there just before the noon break, and at my suggestion I asked Mr. Grushaw if it would be possible to wait, so that we might inspect this belt when it was stopped. [**144]

Q112. Did you do so? A. We did.

Q113. What was the condition of the belt? A. The condition of the belt was very oily, very dirty; but my principal interest in this belt was to check on the condition of the vulcanized flights.

Q114. And what was the condition of the flights? A. The belt did not show any separation of the flights vulcanized to the belt.

Q115. Then how would you characterize the condition and use of the belt at the Ford plant? A. I would say that the condition of the belt and the usage of the belt was very satisfactory.

* * *

Haultain attacks Peddicord's testimony, that he saw the belt at Ford in May of 1952, [***9] on the ground he made conflicting statements showing he was in California at the time. We have carefully read the testimony and are not persuaded it is self-contradictory in this respect or that Peddicord was an unreliable witness.

Haultain again argues that the Ford belt does not, upon inspection, appear to support the count due to the absence of a superficial rubber-like portion. The board

indicated that it felt the argument was of no merit and we agree.

The record next shows that on June 4, 1952, there was a verbal order for and a request from Ford for quotations on two 72-foot cleated belts, on June 6, 1952, the quotations were supplied, and on June 20, 1952, [*871] there was a written Ford order for the belts confirming the verbal order. The belts themselves were shipped to Ford on July 23, 1952.

[4] The purchase by Ford of the two 72-foot belts tends to confirm our opinion that the belt had been successfully tested and operated, as testified by Peddicord, at least as early as June 4, 1952.

[5] Haultain argues that DeWindt was not diligent during a three or four month period during which Haultain conceived and reduced to practice the invention. As we view [***10] the case it is not necessary to consider diligence. For the reasons hereinafter given, we do not believe Haultain had an actual reduction to practice of the invention of the count; rather, he must stand on his filing date, June 9, 1952, for a constructive reduction to practice. This leaves DeWindt as the first to conceive and the first to reduce to practice.

Haultain has submitted three exhibits F, A-2, and A-3 as indicating his work. Exhibits F and A-2 do not meet the terms of the count. These exhibits were testified to as being indicative of the types of belts actually installed by Haultain and neither of these shows the "gap," as called for in the count, into which the cleat feet are set. Also, in our opinion, neither of them meets the smooth merger limitation of the count. We do not press as strict a definition of smooth merger as did the board, but feel that the cleats of Exhibit A-2 and Exhibit F certainly do not merge smoothly with the web by any definition.

Therefore, Haultain must prove actual reduction to practice of a belt which is similar to his Exhibit A-3 embodiment if he is to meet the terms of the count, for that exhibit, in our opinion, does have a smooth [***11] merger and a "gap."

The record indicates three belts were made by Haultain with the "T" cleat, one for Westinghouse, one for Western Meat Company, and one for the Union Ice Company.

[6] One Edutis testified he saw a belt "approximately like A-3 in operation." We are constrained to hold this is not positive enough identification to establish that the belt installed at Western was the same as A-3, or even nearly like it, for exhibits F and A-2 are "approximately" like A-3. We find no other testimony indicating that A-3 was the type used at Western or elsewhere.

45 C.C.P.A. 866, *; 254 F.2d 141, **;
1958 CCPA LEXIS 197, ***; 117 U.S.P.Q. (BNA) 278

The Westinghouse belt is stated to be exactly the same as Exhibit F since that exhibit was cut therefrom. This belt does not meet the limitations of the count, for reasons above stated. [**145]

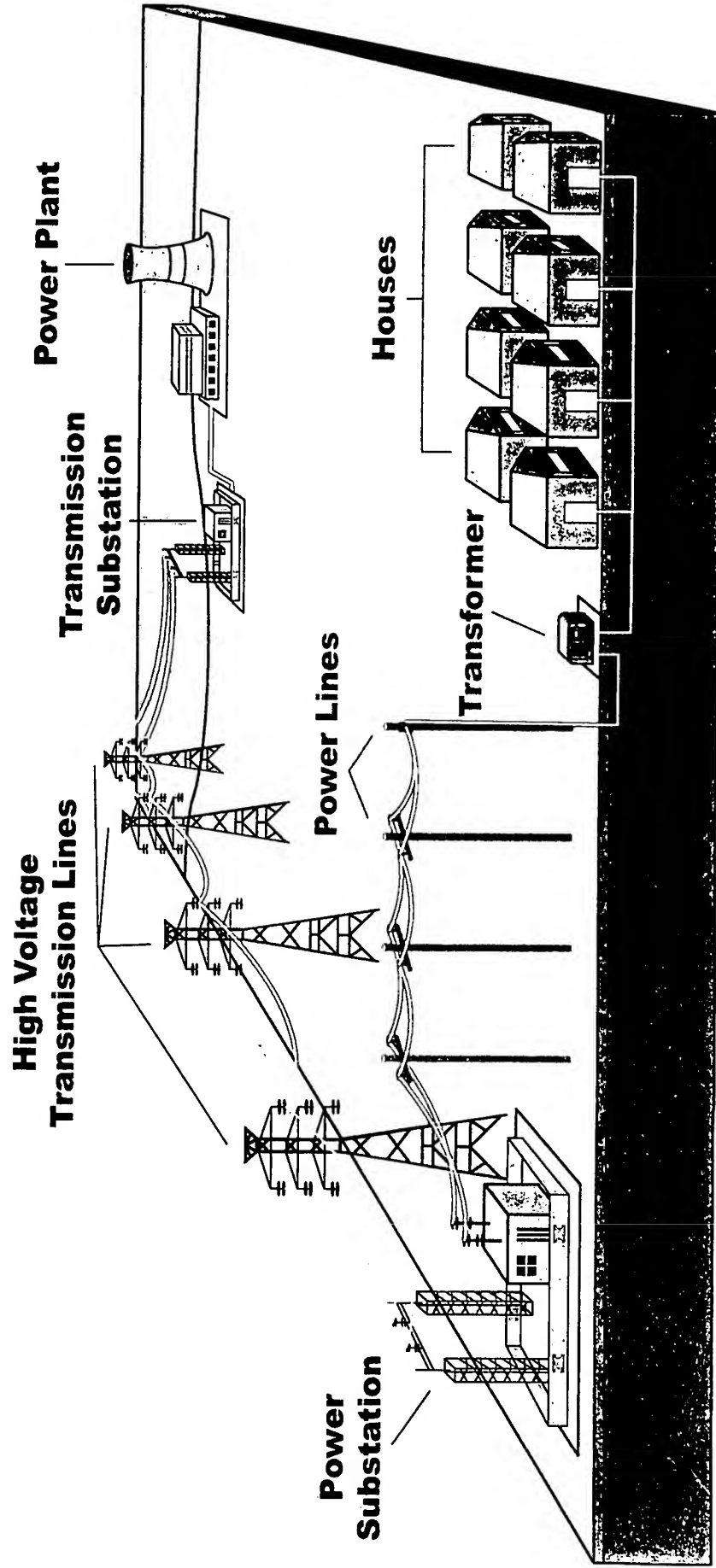
The only other belt made and put in operation by Haultain was the Union Ice Company belt. Mr. Nolting, a maintenance machinist for Union, testified that the Union belt most closely resembled Exhibit A-2 and produced photographs to prove his point. Our examination thereof

indicates closer resemblance to F, but in either case, the count [*872] is not met. Therefore, Haultain must rely upon his filing date for constructive [***12] reduction to practice, which date is five days subsequent to DeWindt's actual reduction to practice. This being so, the party DeWindt must prevail.

The decision of the board is therefore affirmed.

Jackson, J., Retired, recalled to participate.

Power Distribution Overview



Padmount Transformer



Real World Elbow Installation



Cooper Industries and Thomas & Betts Solutions to Problem

COOPER

04/94

Bright Yellow Indicator Ring on Bushing to show proper seating - *Brochure*

ATTENTION: This bushing is equipped with Cooper Power Systems exclusive latch indicator ring, that serves as a visual indicator to verify that the mating component is properly seated on the bushing insert. Once the mating component has been properly installed on the bushing, the yellow ring should be completely covered. If any yellow is visible, the elbow or protective cap must be completely installed or "latched" before energizing to assure a quality connection.

6/94

*108 Patent - Colored band indicator ring on bushing to show proper seating
- *Application Priority Date*

Bright Yellow Indicator Ring

Tab and Indicator Ring

1991 1992 1993 1994 1995 1996 1997 1998 1999 2000 2001 2002 2003 2004 2005 2006

Elongated Tabs

Optional White Band

Optional Bright Yellow Band

10/21/91

Elongated grounding tabs to aid in proper seating
Estimate Product Bulletin PB 400-10-91

06/94

Optional white band to show proper seating
"Get Smart" Newsletter

07/95

Optional white band to show proper seating
- *New Product Review*

06/98

Yellow band for seating indication
- *Loadbreak 2000 Brochure*